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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,518	06/11/2001	Paula F. Delano	END920010011US1	4253

23550 7590 10/18/2005

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EXAMINER
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COLON, CATHERINE M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/878,518

Applicant(s)

DELANO ET AL.

Examiner

C. Michelle Colon

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The following is a Final Office Action in response to the communication received on July 27, 2005. Claims 1, 3, 7, 13, 16, 22, 26 and 31 have been amended. Claims 1-35 are now pending in this application.

#### ***Response to Amendment***

2. Applicant's amendments to claims 1, 3, 7, 13, 16, 22, 26 and 31 are acknowledged.

The amendments are sufficient to overcome the claim objection of claim 3 set forth in the previous Office Action. Therefore, the claim objection of claim 3 is withdrawn.

The amendments are sufficient to overcome the 35 U.S.C. 112, second paragraph rejection of claims 1-3, 5, 6 and 16-35 set forth in the previous Office Action. Therefore, the 35 U.S.C. 112, second paragraph rejection of claims 1-3, 5, 6 and 16-35 is withdrawn.

The amendments are sufficient to overcome the 35 U.S.C. 101 rejection of claims 1-15 set forth in the previous Office Action. Therefore, the 35 U.S.C. 101 rejection of claims 1-15 is withdrawn.

#### ***Response to Arguments***

3. Applicant's arguments have been fully considered, but are found unpersuasive. In the Remarks, Applicant argues the following: 1) that Puri fails to teach analyzing

software application needs of a business entity; and 2) that assigning a value to responses to questions is not obvious to one skilled in the art.

In response to argument 1), Examiner respectfully disagrees. In col. 5, lines 1-15, 28-30 and Figure 4, Puri discloses a needs assessment interface that gathers the business needs of a business entity, analyzes the needs and recommends products, or software applications, identified to meet the needs. Item 52 in Figure 4 lists specific business needs such as information publishing and electronic commerce. The product recommendations discussed in Puri include software applications (col. 5, lines 63-65; Figure 9). In col. 3, lines 61-66, Puri even provides an example of a recommended product being an enterprise management system, which includes software applications and which applies to business entities. Thus, Examiner respectfully submits Puri does disclose analyzing software application needs of a business entity.

In response to argument 2), Examiner respectfully disagrees. Examiner also directs Applicant to Mancisidor et al. (U.S. 6,745,172), cited in the previous Office Action, which discusses assigning values to customer's (i.e., business entity's) responses to needs assessment questions (col. 6, lines 52-55) and rating, or weighting, products to classify them as being suitable for addressing the customer's needs (col. 6, line 56-col. 7, line 11; col. 27, lines 53-61; Figures 17 and 18). Accordingly, Examiner submits it is old and well known, and thus, was obvious at the time of the invention, to assign values to responses to questions in the art of customer software/technology needs assessment.

The remainder of Applicant's arguments relating to the newly amended claims have been addressed in the updated rejection provided below.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite "entity" and "business entity" throughout. It is unclear whether an "entity" and a "business entity" are supposed to be the same or different entities. Accordingly, there is insufficient antecedent basis for this limitation in the claims. Additionally, since it is unclear whether the "entity" and the "business entity" are the same or different entities, this raises further issues of ambiguity as it is unclear which entity the steps of the methods are directed to. For example, it is unclear which entity is being inventoried or being asked questions.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, 4-9 and 11-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Puri (U.S. 6,064,982).

As per claim 1, Puri discloses a computer-implemented method for analyzing software application needs of a business entity, comprising the steps of:

inventorying a set of entity software applications (col. 2, lines 28-36; col. 3, lines 30-31 and 54-59; col. 4, lines 17-19; Figures 2 and 5; During a needs assessment session of a business entity (i.e., a customer), the system collects the software application (i.e., product) needs of the business entity, and therefore, identifies, or inventories, the business entity's current software application status. Additionally, the smart configurator tool maintains a current list of the software applications (i.e., products) of the entity (i.e., or company selling the products), and thus, inventories the products currently available.);

formulating a set of questions related to an entity software application based on a business strategy corresponding to the entity, where the set of questions are tailored to assess the software application needs of the business entity (col. 1, lines 33-35 and 50-53; col. 3, lines 24-26; col. 5, lines 13-15; Figure 4; The system takes the business entity through a series of interactive questions to learn more about the application needs of the business entity. Item 52 in Figure 4 lists specific software application needs such as information publishing and electronic commerce. The business entity identifies its needs by checking the boxes (item 51 in Figure 4) most relevant to its needs.); and

receiving entity responses to the set of questions (col. 5, lines 3-8; Figures 4-6; Entity responses are received through an interactive interface.).

As per claim 2, Puri discloses the method of claim 1, further comprising the step of weighting possible responses to the set of questions based on the business strategy (col. 5, lines 3-15; Figure 4; By allowing an entity to identify needs that are important for its business, the system is in essence weighting the responses. If a particular need is identified, the system guides the entity to answer more questions relating to that need, thereby emphasizing the need.).

As per claim 4, Puri discloses the method of claim 1, further comprising the step of analyzing the received responses to make a set of recommendations (col. 6, lines 5-13 and 43-46; The system provides recommendations to the entity based on the application needs assessment. The application needs assessment includes an interactive tool through which the entity selects from a predetermined question/answer session.).

As per claim 5, Puri discloses the method of claim 1, further comprising the step of generating a report based on the received entity responses (Figure 9).

As per claim 6, Puri discloses the method of claim 1, wherein the entity applications are grouped by business process (item 42 in Figure 4 shows a business process grouping of the needs to be identified by the entity).

Claims 7-9 and 11-35 recite substantially similar subject matter as claims 1, 2 and 4-6 above. Therefore, claims 7-9 and 11-35 are rejected on the same basis as claims 1, 2 and 4-6.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puri (U.S. 6,064,982) as applied above.

As per claim 3, Puri does not expressly disclose the method of claim 2, wherein the step of weighting responses comprises the step of assigning a value for each possible response to the set of questions. However, as discussed in claim 2, by allowing an entity to identify needs that are important for its business and then asking additional questions related to those needs, Puri is emphasizing the identified needs and thus, weighting the responses (col. 5, lines 3-15; Figure 4). Assigning a value to a weight is old and well known in the art. Thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art for the system of Puri to assign values to the needs identified by an entity because doing so allows the system to associate each identified need with a specific worth, providing the system with more



Art Unit: 3623

accurate and quantifiable data with which to conduct the needs assessment, which is a goal of the Puri system (col. 6, lines 43-46).

Claim 10 recites substantially similar subject matter as claim 3 above. Therefore, claim 10 is rejected on the same basis as claim 3.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Mancisidor et al. (U.S. 6,745,172) discusses an expert system used to recommend technology solutions based on customers' needs;

- Forth et al. (U.S. 6,853,978) discusses a system and method for creating custom software applications; and
- Quinones (U.S. 6,904,449) discusses a system for improving existing application infrastructures.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Colon whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

***Alexandria, VA 22313-1450***

Art Unit: 3623

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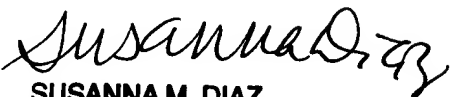
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SMC

October 14, 2005

  
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